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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,394	09/08/2003	William J. Mertz	1248 P 122	9357

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MCDERMOTT, WILL & EMERY LLP  
227 WEST MONROE STREET  
CHICAGO, IL 60606-5096

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/657,394

**Applicant(s)**

MERTZ ET AL.

**Examiner**

Margaret G. Moore

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 3, 5 to 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 3, 5 to 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 to 3, 5 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al.
3. Claims 1 to 3, 5 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckberg et al. '480.
4. Claims 1 to 3, 5 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckberg et al. '453.
5. Each of these rejections is based on the rationale noted in the previous office action. As such this rationale will not be repeated. Applicants provide various arguments as to why and/or how the prior art differs from that claimed. They rely on the results submitted in the Declaration of 3/17/08 in an effort to establish an inherent difference. This is not sufficient in establishing an inherent and unobvious difference.

For the most part, particularly for the Eckberg et al. references, it is unclear what, exactly, applicants are comparing and how it corresponds to the prior art. For the '480 patent, applicants use UV-9400 and UV9390C but Eckberg et al. do not use these products. In fact, Eckberg et al. prepare their own UV curable silicone compositions. It is unclear how the silicones in the Declaration compare to that in the prior art. It is very important to note that it is unclear how the teaching in '480 that the reaction mixture is devolatilized to remove low molecular weight linear and cyclic light ends is accomplished in the comparative example of the Declaration. This applies as well to Eckberg et al. '453. It is unclear what the A formula and B formula are and how they correspond to the teachings in '453 since '453 prepares a UV silicone curable composition and does not rely on the commercially available silicone compositions used in the Declaration. Also it is unclear how the Declaration examples conducted the toluene and other light ends removal noted on the bottom of column 8 in '453.

In addition to the above, the Examiner has other concerns with the results found in the Declaration. For instance, each coating is applied in a different amount per area. It is unclear how this effects the results. Also the results on page 3 do not indicate the ppm volatile silicone compounds level. Since this is one of the limitations in the claims, it is difficult to compare the examples, both inventive and comparative, to the claims and determine an inherent and unobvious difference. In addition, since the extractables of some of the prior art examples fall within the claimed range of no more than 1.5 microgram/sq. cm (for instance '453 (B)) this too raises questions as to any inherent and/or unobvious difference.

Furthermore, it is unclear how each of the compositions were treated to form the release liner and determine how they actually correspond to the prior art compositions. Even the inventive comparisons are unclear since Example 6 of the present application does not contain a "Generation 2" or "Generation 3" example. Finally, it is unclear how any process steps that occurred in the examples compare to the claimed process steps in these product by process claims. Perhaps the compositions were treated to 200°C heat for 2 hours, but this is not a necessary requirement in the claims. It is unclear if any results are commensurate in scope with the claim limitations.

As can be seen, there are numerous issues raised by the Declaration under 37 C.F.R. 1.132 that render it insufficient in overcoming the above rejections.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
6/8/08